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1           UNITED STATES PATENT AND TRADEMARK OFFICE

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4           BEFORE THE BOARD OF PATENT APPEALS  
5           AND INTERFERENCES

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8           *Ex parte SCOTT CLARE and NEIL G. LONG*

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11           Appeal 2008-0339  
12           Application 09/083,422  
13           Technology Center 3600

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16           Decided: May 16, 2008

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19 *Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD and JOSEPH*  
20 *A. FISCHETTI, Administrative Patent Judges.*

21

22 *PATE, III, Administrative Patent Judge.*

23

24           DECISION ON APPEAL

25

26           STATEMENT OF CASE

27           The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final  
28 Rejection of claims 49-56, 58-62, 64-73, 85, 86, 88, 89, 91, 92, 98, 99, 101,  
29 105, 106, 108, 109, 111 and 113. Claims 94, 96, 97, 126 and 127 have been  
30 allowed and claims 57, 74 and 87 have been indicated to be allowable if

1Appeal 2008-0339  
2Application 09/083,422

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1rewritten in independent form. All remaining claims have been previously  
2canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

3       The Appellants claim a storage system for a vehicle that is accessible  
4through an exterior side panel of the vehicle.

5       Independent claim 49 reads as follows:

6           49. A storage system for a vehicle having a driver  
7           compartment and a passenger compartment rearward of the  
8           driver compartment and within a single enclosure, wherein the  
9           enclosure is defined by a floor, a roof, two opposing side walls  
10          which each connect the roof to the floor, and exterior side  
11          panels, wherein the passenger compartment includes opposing  
12          rear wheel wells extending into the passenger compartment  
13          from the bottom edges of the side panels,

14           the storage system comprising at least one storage area  
15          adjacent to and separated from the passenger compartment, the  
16          storage area being defined by at least a portion of an exterior  
17          side panel, an inner panel, a top and bottom which connect the  
18          inner panel to the exterior side panel, and wherein the storage  
19          area extends into the passenger compartment no further than the  
20          wheel well extends into the passenger compartment,

21           wherein at least one section of the exterior side panel is  
22          hinged to provide access to the storage area therein.  
23

24       Independent claim 61 recites a similar storage area in a vehicle having  
25forward and rear compartments, the separation width and cross sectional  
26contour of the side panels of the enclosure being substantially the same as  
27the separation width and cross sectional contour of the forward  
28compartment.

29       Independent claim 85 also recites a similar storage area in a vehicle  
30with at least two rows of seats where the width of the storage area is not

6Appeal 2008-0339  
7Application 09/083,422  
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1greater than the width of the wheel well, and the storage area includes a latch  
2and a strut for retaining the hinged section in the open position.

3       The prior art relied upon by the Examiner in rejecting the claims is:

4Hawkins	2,159,022	May 23, 1939
5Stahl	2,192,207	Oct. 13, 1937
6Sparling	4,315,653	Feb. 16, 1982
7Gallagher	5,709,309	Jan. 20, 1998
8Powers	Des. 143,990	Apr. 28, 1945
9Hamel	Des. 230,351	Feb. 12, 1974

10       The Examiner rejected claims 49-55, 58, 60, 98, 99, 101, 106, 108 and  
11109 under 35 U.S.C. § 103(a) as unpatentable over Sparling in view of  
12Hawkins and Stahl<sup>1</sup>.

13       The Examiner rejected claims 61, 62, 64-68, 70-72, 111 and 113  
14under 35 U.S.C. § 103(a) as unpatentable over Stahl in view of Hawkins.

15       The Examiner rejected claims 85, 86, 89, 91 and 92 under 35 U.S.C.  
16§ 103(a) as unpatentable over Stahl or Sparling in view of Hawkins and  
17Hamel.

18       The Examiner rejected claims 56 and 73 under 35 U.S.C. § 103(a) as  
19unpatentable over Sparling or Stahl in view of Hawkins and Hamel.

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10<sup>1</sup> The Examiner cites Stahl in this rejection for the first time in the  
11Examiner's Answer (Ans. 3). The Appellants note that this is a new ground  
12of rejection but request the appeal be maintained (Reply Br. 3).

14Appeal 2008-0339  
15Application 09/083,422  
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1       The Examiner rejected claims 59 and 88 under 35 U.S.C. § 103(a) as  
2unpatentable over Sparling or Stahl in view of Hawkins, optionally in view  
3of Hamel, and further in view of Gallagher et al.

4       The Examiner rejected claims 69 and 73 under 35 U.S.C. § 103(a) as  
5unpatentable over Stahl in view of Hawkins and Hamel.

6       The Examiner rejected claim 105 under 35 U.S.C. § 103(a) as  
7unpatentable over Sparling in view of Hawkins and Powers.

8       We AFFIRM.

9

10                   ISSUES

11       The following issues have been raised in the present appeal.

12       1.       Whether the Appellants have shown that the Examiner erred in  
13rejecting claims 49-55, 58, 60, 98, 99, 101, 106, 108 and 109 as unpatentable  
14over Sparling in view of Hawkins and Stahl.

15       2.       Whether the Appellants have shown that the Examiner erred in  
16rejecting claims 61, 62, 64-68, 70-72, 111 and 113 as unpatentable over  
17Stahl in view of Hawkins.

18       3.       Whether the Appellants have shown that the Examiner erred in  
19rejecting claims 85, 86, 89, 91 and 92 as unpatentable over Stahl or Sparling  
20in view of Hawkins and Hamel.

21       4.       Whether the Appellants have shown that the Examiner erred in  
22rejecting claims 56 and 73 as unpatentable over Sparling or Stahl in view of  
23Hawkins and Hamel.

19Appeal 2008-0339  
20Application 09/083,422  
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1        5. Whether the Appellants have shown that the Examiner erred in  
2 rejecting claims 59 and 88 as unpatentable over Sparling or Stahl in view of  
3 Hawkins, optionally in view of Hamel, and further in view of Gallagher.

4        6.      Whether the Appellants have shown that the Examiner erred in  
5rejecting claims 69 and 73 as unpatentable over Stahl in view of Hawkins  
6and Hamel.

7        7.      Whether the Appellants have shown that the Examiner erred in  
8 rejecting claim 105 as unpatentable over Sparling in view of Hawkins and  
9 Powers.

## FINDINGS OF FACT

12 The record supports the following findings of fact (FF) by a  
13 preponderance of the evidence.

14 1. Sparling discloses a vehicle having a driver compartment and a  
15 passenger compartment rearward of the driver compartment wherein the  
16 passenger compartment includes opposing rear wheel wells 22, 24 extending  
17 into the passenger compartment from the bottom edges of the side panels  
18 (Figs. 3 and 7; Col. 3, ll. 15-20).

19        2. Hawkins discloses a vehicle having a driver compartment and a  
20storage system comprising a storage area defined by a portion of an exterior  
21side panel, an inner panel, a top and a bottom which connect the inner panel  
22to the exterior side panel, and wherein a section of the exterior side panel is  
23hinged to provide access to the storage area (Figs. 1 and 7; Pg. 2, Col. 1, ll.  
2433-51). Hawkins also discloses that the storage area extends no further than

24Appeal 2008-0339  
25Application 09/083,422  
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1the wheel well (Fig. 4). Hawkins further specifically teaches that such a  
2truck allows carrying of a large variety of tools and equipment while  
3facilitating access to the tools and increasing the carrying capacity of the  
4truck (Pg. 1, Col. 1, ll. 8-13).

5       3.     Stahl discloses a vehicle having a driver compartment and a  
6passenger compartment rearward of the driver compartment that is within a  
7single enclosure (Figs. 1 and 4; Pg. 1, Col. 2, l. 45-Pg. 2, Col. 1, l. 2). Stahl  
8also discloses a storage system comprising a storage area adjacent to, and  
9separated from, the passenger compartment, the storage area extending into  
10the passenger compartment (Figs. 1-4; Pg. 2, Col. 1, ll. 25-54). Stahl teaches  
11the desirability for providing within the vehicle, a seating arrangement for  
12numerous men as well as adequate storage space (Figs. 1-4; Pg. 1, Col. 1, ll.  
137-44). The separation width and cross sectional contour of the side panels of  
14the enclosure in Stahl is substantially the same as the separation width and  
15cross sectional contour of the forward compartment where it adjoins the side  
16panels (Figs. 4 and 5).

17       4.     Hamel discloses a vehicle including at least one hinged section  
18in the exterior surface of a side panel, at least one storage area located  
19adjacent the hinged section, a latch for retaining the hinged section in the  
20closed position, and a strut for retaining the hinged section in the open  
21position (Figs. 1 and 4).

22       5.     Powers discloses a vehicle having a storage area defined by a  
23portion of an exterior side panel that is hinged, the width of the storage area  
24being approximately the same as the width of the wheel well (Figs. 1-5).

1

## PRINCIPLES OF LAW

2       “Section 103 forbids issuance of a patent when ‘the differences  
3 between the subject matter sought to be patented and the prior art are such  
4 that the subject matter as a whole would have been obvious at the time the  
5 invention was made to a person having ordinary skill in the art to which said  
6 subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727,  
7 1734 (2007). The question of obviousness is resolved on the basis of  
8 underlying factual determinations including (1) the scope and content of the  
9 prior art, (2) any differences between the claimed subject matter and the  
10 prior art, (3) the level of skill in the art, and (4) where in evidence, so-called  
11 secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18  
12 (1966). In *KSR*, the Supreme Court reaffirmed principles based on its  
13 precedent that “[t]he combination of familiar elements according to known  
14 methods is likely to be obvious when it does no more than yield predictable  
15 results.” *KSR*, 127 S.Ct. at 1739. The Court also explained that “[w]hen a  
16 work is available in one field of endeavor, design incentives and other  
17 market forces can prompt variations of it” and that “[i]f a person of ordinary  
18 skill can implement a predictable variation, §103 likely bars its  
19 patentability.” *Id.* at 1740. The Court noted that “[t]o facilitate review, this  
20 analysis should be made explicit,” but “the analysis need not seek out  
21 precise teachings directed to the specific subject matter of the challenged  
22 claim” *Id.* at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

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34Appeal 2008-0339  
35Application 09/083,422  
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## ANALYSIS

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### Claims 49-55, 58, 60, 98, 99, 101, 106, 108 and 109

3

The Examiner rejected these claims as unpatentable over Sparling, Hawkins and Stahl (Ans. 3). The Appellants argue these claims as a group (App. Br. 4-6). Thus, we select independent claim 49 to decide the appeal with respect to this group of claims, claims 50-55, 58, 60, 98, 99, 101, 106, 7108 and 109 standing or falling with claim 49. *See* 37 C.F.R. § 41.37(c)(1) 8(vii) (2007).

9

The Appellants argue that the vehicles of Hawkins and Stahl are commercial utility trucks and should not be combined with Sparling which is a pick-up truck with a camper top that does not disclose any storage system or problems associated thereto (App. Br. 5 and 6; Reply Br. 4). Thus, the Appellants argue that the Examiner has failed to establish *a prima facie* case of obviousness because the Examiner has not identified any suggestion to combine the references within the references themselves and has also failed to provide an objective reason for combining the references (App. Br. 5). The Appellants further argue that the vehicle of Sparling also cannot be combined with the storage systems of Hawkins because such a combination would destroy the additional passenger seating function of Sparling (App. Br. 10).

21

However, we note that the Examiner is not required to seek out precise teachings directed to the specific subject matter of the claim. *KSR*, 23127 S.Ct. at 1741. We also disagree with the Appellants contention that the applicable prior art is limited to non-commercial vehicles. Hawkins teaches

1the desirability of providing storage area in a vehicle that is accessed from  
2the exterior side panel for carrying tools and equipment, for facilitating  
3access to such tools, and for increasing the carrying capacity of the truck (FF  
42). Stahl similarly teaches the desirability for providing a seating  
5arrangement for numerous men and adequate storage space in a vehicle that  
6includes a storage area accessible from the exterior side panel (FF 3).

7        In contrast to the Appellants' assertion that the Examiner has not  
8articulated a motivation to combine these references, the Examiner stated  
9that "it would have been obvious to one of ordinary skill to provide in  
10Sparling a storage compartment . . . in order to store tools, spare parts, etc.  
11away from the passenger compartment" (Final Office Action 2). Thus, the  
12Examiner has articulated a rational reason for providing the storage  
13compartment of Hawkins in the vehicle of Sparling based on the teachings  
14of Hawkins. Similar analysis applies with respect to Stahl which teaches the  
15desirability of adequate storage space and seating (FF 3). With respect to  
16the Appellants' argument that the passenger seating function of Sparling  
17would be destroyed, we note that the storage area in the vehicle of Stahl is  
18provided without destroying the passenger seating function thereof (Stahl:  
19Figs. 1, 3 and 4).

20        In view of the above, we agree with the Examiner that independent  
21claim 49 is unpatentable over Sparling in view of Hawkins and Stahl. Thus,  
22we find that the Appellants have failed to show that the Examiner erred in  
23rejecting claims 49-55, 58, 60, 98, 99, 101, 106, 108 and 109 as  
24unpatentable.

1

2       Claims 61, 62, 64-68, 70-72, 111 and 113

3       The Appellants argue these claims as a group (App. Br. 6 and 7).  
4 Thus, we select independent claim 61 to decide the appeal with respect to  
5 this group of claims, claims 62, 64-68, 70-72, 111 and 113 standing or  
6 falling with claim 61. *See* 37 C.F.R. § 41.37(c)(1)(vii).

7       The Appellants traverse this rejection asserting that Stahl cannot be  
8 properly combined with Hawkins, that the Examiner has failed to establish  
9 motivation for combining these references, and that the combination still  
10 fails to result in the invention claimed (App. Br. 6). The Appellants argue  
11 that Stahl is a utility truck where the storage area is separated from the driver  
12 and passenger compartments by partition 8 (App. Br. 6). Thus, the  
13 Appellants assert that combining the storage system of Hawkins with the  
14 vehicle of Stahl does not result in limiting the storage to a width not greater  
15 than the wheel well and that the Examiner has failed to establish a *prima*  
16 *facie* case of obviousness (App. Br. 6 and 7).

17       The Appellants' arguments are not persuasive because Stahl discloses  
18 side members 11 with storage spaces and doors 12 that permit access to the  
19 storage spaces from the exterior of the vehicle (Pg. 2, Col. 2, ll. 25-31). It is  
20 these storage spaces to which the Examiner applies the teachings of  
21 Hawkins, not the compartment defined by the partition 8 (Final Office  
22 Action 4). As can be clearly seen by the cross sectional view of Figure 4,  
23 the storage area of Hawkins extends into the enclosure less than the wheel  
24 well (FF 2). The Examiner has further articulated that it would have been

1obvious to one of ordinary skill in the art to extend the storage spaces of  
2Stahl into the enclosure less than the wheel well as shown in Hawkins so as  
3to maximize the interior space of the larger compartment that is defined by  
4the partition (Final Office Action 4). The Examiner's articulated rationale is  
5reasonable in view of the competing interest in providing the maximum  
6interior space of the larger compartment defined by the partition while also  
7providing a usable storage space that is accessible from the exterior of the  
8vehicle.

9       Therefore, in view of the above, we agree with the Examiner that  
10 independent claim 61 is unpatentable over Stahl in view of Hawkins. Thus,  
11 we find that the Appellants have failed to show that the Examiner erred in  
12 rejecting claims 61, 62, 64-68, 70-72, 111 and 113 as unpatentable.

13

14       Claims 85, 86, 89, 91 and 92

15       The Examiner rejected these claims as unpatentable over Sparling or  
16 Stahl in view of Hawkins and Hamel (Final Office Action 4). The  
17 Appellants argue these claims as a group (App. Br. 7 and 8). Thus, we select  
18 independent claim 85 to decide the appeal with respect to this group of  
19 claims, claims 86, 89, 91 and 92 standing or falling with claim 85. *See* 37  
20 C.F.R. § 41.37(c)(1)(vii).

21       The Appellants argue that the Examiner failed to establish  
22 motivation for combining Sparling or Stahl with Hawkins, and also failed to  
23 establish a motivation for combining Hamel as well (App. Br. 7). With  
24 respect to the combination of Sparling or Stahl with Hawkins, we disagree

1with the Appellants for the same reason discussed *supra* regarding the  
2rejection of independent claim 49. Moreover, the Examiner stated that it  
3would have been “obvious to hinge the side panel section at top and support  
4with strut as taught by Hamel as a shelter from rain, for example” (Final  
5Office Action 4). Hence, in contrast to the Appellants’ assertion, the  
6Examiner has articulated a reason with a rational basis as to why one of  
7ordinary skill in the art would utilize the strut for supporting the side panel  
8section in the manner disclosed in Hamel.

9       Therefore, in view of the above, we agree with the Examiner that  
10independent claim 85 is unpatentable over Sparling or Stahl in view of  
11Hawkins and Hamel. Thus, we find that the Appellants have failed to show  
12that the Examiner erred in rejecting claims 85-86, 89, 91 and 92 as  
13unpatentable.

14

15       Claims 56 and 73

16       These claims ultimately depend from independent claims 49 and 61,  
17respectively, and are directed to the inclusion of at least one strut assembly  
18for retaining the hinged section of the side panel in an open position. These  
19claims stand rejected as unpatentable over Sparling or Stahl in view of  
20Hawkins and Hamel (Final Office Action 5). The Appellants contend that  
21this rejection is improper and has been “previously addressed”, presumably  
22in the arguments against the rejection of independent claim 85 which also  
23recites such a strut (App. Br. 8). However, we disagree with the Appellants  
24for the same reason discussed *supra* relative to claim 85. Therefore, the

59Appeal 2008-0339  
60Application 09/083,422  
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1Appellants have not shown that the Examiner erred in rejecting claims 56  
2and 73 as unpatentable.

3

4       Claims 59 and 88

5       These claims stand rejected as unpatentable over Sparling or Stahl in  
6view of Hawkins, optionally in view of Hamel, and further in view of  
7Gallagher (Final Office Action 5). The Appellants merely rely on  
8previously discussed arguments asserting that motivation for combining  
9Sparling, Stahl, Hawkins and/or Hamel has not been established, and further  
10argue that Gallagher does not remedy this deficiency (App. Br. 8).  
11However, we disagree with the Appellants for the reason discussed *supra*  
12relative to independent claims 49 and 85. Therefore, the Appellants have  
13not shown that the Examiner erred in rejecting claims 59 and 88.

14

15       Claims 69 and 73

16       Claim 69 relates to positioning of the hinged section while claim 73  
17relates to a strut assembly. The Examiner rejected these claims as  
18unpatentable over Stahl in view of Hawkins and further in view of Hamel  
19(Final Office Action 5). The Appellants merely rely on previously discussed  
20arguments asserting that motivation for combining Stahl, Hawkins and  
21Hamel has not been established (App. Br. 9). However, we disagree with  
22the Appellants for the reason discussed *supra* and find that the Appellants  
23have not shown that the Examiner erred in rejecting claims 69 and 73.

24

1        Claim 105

2        Claim 105 which recites that the width of the storage area is  
3approximately the same as the width of the wheel well stands rejected as  
4unpatentable over Sparling in view of Hawkins and Powers (Final Office  
5Action 5). The Appellants contend that claim 105 is not directed to a  
6vehicle with modified wheel wells and that the Examiner has not established  
7motivation to combine Sparling and Hawkins (App. Br. 9; Reply Br. 6).

8        We again agree with the Examiner that Sparling and Hawkins can be  
9properly combined as discussed *supra* relative to the Examiner's rejection of  
10independent claim 49 from which claim 105 ultimately depends. In  
11addition, the basis of the Appellants' argument regarding the wheel well is  
12not well founded or fully understood. The Examiner is not suggesting  
13modification of the wheel well so that it extends into the passenger  
14compartment as Sparling already discloses such a feature (FF 1). Instead,  
15the Examiner is stating that it would have been obvious to one of skill in the  
16art that the storage area of the combination of Sparling and Hawkins can be  
17implemented in view of Powers to result in the invention of claim 105  
18because Powers specifically shows a storage area having a width that is  
19approximately the same as the width of the wheel well (Final Office Action  
205; FF 5). The Examiner states the reason for providing such a combination  
21is for increasing the storage volume of the vehicle (Final Office Action 5).  
22We agree with the Examiner's and find that the claimed invention is merely  
23a predictable variation of the storage area that is likely unpatentable. *See*

69Appeal 2008-0339  
70Application 09/083,422  
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<sup>1</sup>KSR, 127 S.Ct. at 1740. Thus, the Appellants have not shown that the  
<sup>2</sup>Examiner erred in rejecting claim 105.

3

## CONCLUSION

5 On the record before us, Appellants have not shown that the Examiner  
6 erred in rejecting claims 49-56, 58-62, 64-73, 85, 86, 88, 89, 91, 92, 98, 99,  
7 101, 105, 106, 108, 109, 111 and 113 as unpatentable over the prior art of  
8 record.

9

## ORDER

11 The Examiner's rejections of claims 49-56, 58-62, 64-73, 85, 86, 88,  
1289, 91, 92, 98, 99, 101, 105, 106, 108, 109, 111 and 113 are AFFIRMED.

13        No time period for taking any subsequent action in connection with  
14 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
15 § 1.136(a)(1)(iv) (2007).

16

AFFIRMED

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19 JRG

20

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